

## **REMARKS**

### **I. Introduction**

Claims 1 to 26 are pending in the present application after the addition of new claims 23 to 26. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1 to 22 Under 35 U.S.C. §103(a)**

Claims 1 to 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent No. 6,015,389 ("Brown") and U.S. Patent No. 6,363,275 ("Kaiser"). Applicants respectfully submit that the combination of Brown and Kaiser does not render unpatentable the present claims for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). It is respectfully submitted that the Office Action has clearly failed to establish a *prima facie* case of obviousness.

Regarding the requirement that the prior art references teach or suggest all of the claim limitations, neither Brown nor Kaiser disclose, or even suggest, at least the features of a first set of electrodes positioned in a first plane, a second set of electrodes positioned in a second plane, the second plane being different from the first plane, and a third set of electrodes positioned in a third plane between the first and second planes. The Office Action broadly asserts, however, that "Brown clearly teaches the electrodes do not necessarily have to be arranged in a common plane and the invention can be using more than four electrodes ...." Office Action, page 2. Applicants respectfully disagree with this statement. Furthermore, regardless of whether Brown teaches that "electrodes do not necessarily have to be arranged in a common plane and the invention can be using more than four electrodes," as

alleged in the Office Action, Brown still does not disclose or suggest the specific arrangement set forth in claim 1. As set forth in the Specification, the specific arrangement of electrodes recited in claim 1, *i.e.*, having electrodes in three different specifically defined planes, provides detailed information concerning the resistivity in the measurement areas while increasing the number of independent components to calculate a particular resistivity distribution, thereby improving the resolution of the image generated thereby. *See, e.g.*, Specification, page 16, first paragraph.

The M.P.E.P. and Federal Circuit have made it clear, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03 and *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claim 1 specifically recites a first set of electrodes positioned in a first plane and a second set of electrodes positioned in a second plane, the second plane being different from the first plane, and a third set of electrodes positioned in a third plane between the first and second planes, wherein the third set of electrodes is rotatable around an axis intersecting the third plane. For at least the reasons set forth in Applicants' previous response, Brown does not disclose at least the aforementioned features of claim 1. Kaiser is not relied upon for disclosing at least the aforementioned features of claim 1 not disclosed by Brown. The Office Action merely asserts that Kaiser discloses a device for treating tumors including an electrode arrangement where the electrodes are rotatable about an axis X-X ...." Office Action, page 3. Indeed, it is respectfully submitted that Kaiser does not disclose, or even suggest, at least the features of a first set of electrodes positioned in a first plane and a second set of electrodes positioned in a second plane, the second plane being different from the first plane, and a third set of electrodes positioned in a third plane between the first and second planes. As such, it is respectfully submitted that the combination of Brown and Kaiser does not render unpatentable claim 1 for at least the reason that these references do not teach or suggest all of the features recited in claim 1.

Applicants also respectfully point out that the recitation in claim 1 that "the third set of electrodes is rotatable around an axis intersecting the third plane" is a structural limitation. The recitation of electrodes that are rotatable necessitates a structure that allows for rotation. *See, e.g.*, Figure 2(a) and the Specification, page 6, second paragraph, which show and describe an electrode supporting unit 104 that is rotatably mounted within housing 102. Accordingly, Applicants respectfully disagree with the Office Action's assertion that "the rotatability of the electrodes is functional language and do not further limit the structural elements of claim 1." Furthermore, this statement seems inconsistent in view of the

arguments made in the Office Action. If, as the Office Action asserts, the rotatability of the electrodes is functional language that does not further limit the structural elements of claim 1, then the Office Action's citation of Kaiser as allegedly disclosing this feature would have been unnecessary.

The present rejection is also deficient because there is no teaching or suggestion to combine Brown and Kaiser. A teaching or suggestion to make the claimed combination may **not be based on the application's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Office Action, however, asserts that "since Brown does not teach or suggest rotating the electrodes around an axis, a new reference is cited to address this function." Office Action, page 2. The Office Action is using the Applicants' disclosure as a road map to make the proposed combination. As such, the present rejection is apparently based on nothing more than improper hindsight, which cannot support an obviousness rejection.

Furthermore, regarding the requirement that the **references** must provide a suggestion or motivation for making the proposed modification, the present rejection is plainly deficient. The Office Action contends that Brown and Kaiser are "[i]n the same field of endeavor" and that

[i]t would have therefore been obvious ... to use the teaching by Kaiser to modify the teaching by Brown for the purpose of generating a current density distribution in other planes as well for improved resolution.

Office Action, page 3. These are not suggestions or motivations for making the proposed combination but instead conclusory statements. Indeed, there is no indication whatsoever of a suggestion or motivation by Brown or Kaiser to make the proposed combination. Merely because certain references **can** be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

If the desirability of the combination cannot be found in the prior art, then a rationale must be provided that is reasoned from knowledge generally available to one of ordinary skill in the art, based on established scientific principles, or based on legal precedent established by prior case law. *See* M.P.E.P. 2144. At least a convincing line of reasoning must be presented to support the rejection. *Ex Parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). It is respectfully submitted that the Office Action has not provided any

convincing line of reasoning for making the proposed modification. Instead, as discussed above, the Office Action merely relies on conclusory statements that it would have been obvious to combine the references to achieve an end result, *i.e.*, for the purpose of generating a current density distribution, which cannot support an obviousness rejection. As such, the present rejection is apparently based on nothing more than improper hindsight, which cannot support an obviousness rejection.

As for claims 2 to 22, which ultimately depend from and include all of the limitations of independent claim 1, it is respectfully submitted that the combination of Brown and Kaiser does not render these dependent claims unpatentable for at least the same reasons given above in support of the patentability of independent claim 1. Additionally, it is noted that the Office Action has failed to address the additional claim limitations recited in claims 2 to 22. It is respectfully submitted that the combination of Brown and Kaiser does not disclose or suggest the additional claim limitations recited in claims 2 to 22. Accordingly, it is respectfully submitted that the combination of Brown and Kaiser does not render unpatentable claims 2 to 22.

### **III. New Claims 23 to 26**

New claims 23 to 26 have been added herein. It is respectfully submitted that new claims 23 to 26 do not add any new matter and are fully supported by the present application, including the Specification. Support for new claims 23 to 26 may be found, *e.g.*, at page 6, second paragraph; page 8, second paragraph; and page 11, third paragraph to page 12, first paragraph of the Specification. It is respectfully submitted that claims 23 to 26 are patentable over the references relied upon.

**IV. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

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Respectfully submitted,

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